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REMARKS

Appreciation is hereby expressed for the very thorough and professional Office Action. Pursuant to the Office Action, Claim 6 has been cancelled and the subject matter of Claim 6 incorporated in original Claim 1. Also, Claim 10 has been amended to change its dependency to Claim 1. The present amendment is deemed not to introduce new matter. Claims 1-5 and 7-12 remain in the application.

Reconsideration is respectfully requested of the objection to Claims 1-12 based on informalities. Claim 1 has now been amended to incorporate the term "comprising" which is believed to obviate the rejection. Withdrawal of the objection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-8 under 35 U.S.C. 102(b) as being anticipated by Mori, et al. '482.

This rejection is believed to be erroneous for several reasons. First, the Examiner's reliance upon 35 U.S.C. 102(b) is misplaced for the reasons discussed below.

35 U.S.C. 102(b) provides that a person shall be entitled to a patent unless

"(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States"

MPEP 706.02(a) provides, in pertinent part, that:

"In order to determine which section of 35 U.S.C. 102 applies, the effective filing date of the application must be determined and compared with the date of the reference. See MPEP § 706.02 regarding determination of effective filing date of the application."

In addition, MPEP 1893.03(b) provides, in pertinent part, that:

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“And international applications designating the US has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.”

--- and

“For most legal purposes, the filing date is the PCT international filing date.”

In view of the foregoing, it is clear from the MPEP that it is the task of the Examiner to determine the effective filing date of the present application. The present application is a national stage PCT application as evidenced specifically by the form PCT/DO/EO/903(371 Acceptance Notice) which was mailed from the U.S. PTO on 12/22/2004 and is a part of the record of this case.

The 371 Acceptance letter indicates in the upper right-hand corner thereof that the present application is entitled to an international application filing date of January 20, 2003. Please note in the first paragraph of the 371 Acceptance letter that the U.S. Patent and Trademark Office has determined that:

“The above-identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.”

On the basis of this determination as set forth in the 371 Acceptance letter, it is respectfully submitted that the present application has been accorded an effective filing date of January 20, 2003.

It is also respectfully submitted that this effective filing date is the filing date to be considered in any rejection under 35 U.S.C. 102(b).

In the present case, the Examiner's prior art reference of Mori, et al., U.S. Patent 6,490,482 B2 issued on December 3, 2002, has a prior publication date of May 9, 2002. It is therefore clear that the Mori, et al. patent was neither issued nor published more than one year prior to the effective filing date of the present application for patent. Consequently, the rejection fails as a matter of law in view of the above authorities. Therefore, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In any event, in the rejection, the Examiner indicates that Mori, et al. discloses a reservoir (43), a cup backing (44) and comb electrodes (22). However, the comb electrodes (22) is affixed to the agent permeable membrane 21, as disclosed in paragraph 3, lines 2-3. That is, the comb electrodes (22) are provided on the membrane 21 as shown in Fig. 2, not reservoir (43).

Since electroporation is more effective when an electroporation electrode directly contacts an application site, it is necessary that a compound to be administered also contacts an application site at the same time as the electrode. However, there are almost no examples of using a preparation that integrates an electrode and a compound to be administered in this manner to simultaneously administer an electrode and a compound to be administered (Specification, page 2, lines 13-20).

The only example in which this is enabled is disclosed in WO99/22810, in which an electrode is retained on a permeable membrane (hereunder, referred to as an "electrode membrane").

In this case, an electrode membrane was employed to retain (cover) a solution or gel to enable preparation of a pharmaceutical product. While this method is suitable for retention purposes, it has problems such as that a membrane may be difficult to permeate depending on a compound, and that adsorption is caused (Specification, page 2, line 20 to page 3, line 1). The reference WO99/22810

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disclosed above is a patent family member of Mori, et al., USPN 6,490,482, cited in this Office Action.

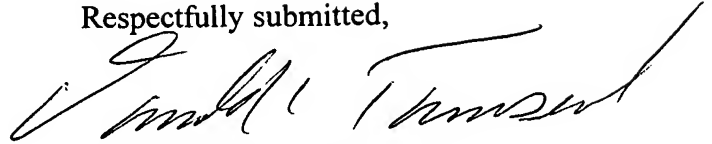
It is respectfully submitted that there is no disclosure whatever in Mori, et al. of a preparation for transdermal or transmucosal administration for electroporation of a compound reservoir having dispersed therein a compound to be administered in a base of a solid or semisolid form, a backing retaining the compound reservoir, and at least one pair of electrodes for electroporation provided on the compound reservoir. On the contrary, that teaching or suggestion comes only from the present application and constitutes an important aspect or element of the present invention. Therefore, it is respectfully submitted that the Mori, et al. reference fails to anticipate or render unpatentably obvious the subject matter called for in the claims herein. Consequently, the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In summary, the rejection under 35 U.S.C. 102(b) fails because the Mori, et al. patent was neither issued nor published more than one year prior to the effective filing date of the present application. Further, the Mori, et al. fails to disclose the subject matter called for in the claims herein.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance and early action and allowance thereof is accordingly respectfully requested. If there is any reason why the present application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problem.

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Respectfully submitted,



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Date: August 17, 2006

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CERTIFICATE OF MAILING

I hereby certify that this Amendment and Transmittal in Docket No. MUR-039-USA-PCT,
Serial No. 10/501,946, filed July 21, 2004, was deposited with the United States Postal Service
with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On August 17, 2006.

Donald E. Townsend

